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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,873	06/01/2007	Ronald W. McGhee	16-947	9468
26294 7590 04/23/2009 TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P. 1300 EAST NINTH STREET, SUITE 1700 CLEVEVLAND, OH 44114				
EXAMINER				
SELF, SHELLEY M				
ART UNIT		PAPER NUMBER		
3725				
MAIL DATE		DELIVERY MODE		
04/23/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/552,873

**Applicant(s)**

MCGEHEE ET AL.

**Examiner**

Shelley Self

**Art Unit**

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-14 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 12 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of the invention of Group I (clms. 1-14) in the reply filed on March 2, 2009 is acknowledged.

Claims 15-17 have been cancelled by Applicant's amendment filed March 2, 2009.

### ***Specification***

The disclosure is objected to because of the following informalities:

Page 1 of the Specification should include a claim to cross reference information i.e. this case is a continuation of...

Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

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with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/552856. Although the conflicting claims are not identical, they are not patentably distinct from each other because there are merely reworded and encompass similar subject matter/scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 7,490,641. Although the conflicting claims are not identical, they are not patentably distinct from each other because as noted above regarding co-pending Application 10/552856, the claims of the presently presented application are merely reworded and broader than that of the patented case, '641. Accordingly the narrower claims of the patent '641 serve to anticipate the broadly presented claims of the current application.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claims 1 and 13 neither movable cutting elements nor the movable

guiding elements have been positively recited. What is the means for setting the size operatively coupled/connected to? How does the interrogator mechanically cooperate with the rest of the positively recited limitations?

With regard to claim 5, the claims states, "further comprising the planer", does this refer to the optimized planer recited in the parent claim 1 or is this a separate and distinct planer? If there are two separate planers, how do the two mechanically cooperate? If this is not a different planer, clarification is required, Examiner suggests --wherein said optimizing planer...—

Additionally regard claim 5 there is insufficient antecedent basis for the recitation, "the workpiece data". Clarification is required.

With regard to claim 10 the trimmer has not been positively recited. It is unclear what is being claimed. Examiner notes the claim appears to be more a method/processing step as opposed to a proper apparatus claim as no structure of the parent claim has been further limited by claim 10. Appropriate correction is required.

The claims lack recitation of clear structure, i.e. it is not clear whether or not the claims are drawn to a combination of a planer and optimizing planermill system for the planer or merely an optimizing planermill system. Accordingly the scope of the claim can not be ascertained and a clear understanding of the claimed invention is highly difficult. The claims appear to be written as functional recitations without clear mechanical structure or limitations and thus are not clearly defined. The claims appear to be method or processing step claims as opposed to proper apparatus claims. Clarification is required to facilitate a clear understanding of the claimed invention; the scope of the coverage sought and for proper application of the prior art.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-14 as best as can be understood are rejected under 35 U.S.C. 102(b) as being anticipated by Davenport et al. (5,417,265). Davenport substantially discloses the claimed invention as best as can be understood. Davenport discloses a planer in conjunction with an optimizing planer mill system to feed lumber to the planer; wherein the optimizing planer mill system includes a sheet feeder, a controller, the planer including cutting elements and guiding elements, a control system for controlling the infeed system for delivery of lumber to the planer.

Additionally claims 1-14 as best as can be understood are rejected under 35 U.S.C. 102(b) as being anticipated by Mierau et al. (5,765,617) or Kennedy et al. (5,884,682) or Bowlin et al. (4,879,659). Mierau, Kennedy and Bowlin disclose the claimed invention including a control system (col. 4, par. 1 or col. 13, par 4- col. 14 par. 2 or col. 5 par. 5 respectively), a work piece feed path (10 or col. 15, par. 4- col. 16, line 11 or col. 10, par, respectively), an optimizing planer (70 or col. 16, par. 3 and 4 or col. 10, par. 5 and 6, respectively) and a workpiece interrogator (64 or 136 or 46 and 51, respectively).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure Seffens (4,823,851).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is 571-272-4524. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shelley Self/  
Primary Examiner, Art Unit 3725

SS  
April 22, 2009